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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/644,976	08/21/2003	Shouhei Kozakai	0171-1012P	6358
2292	7590	09/06/2006	EXAMINER	
BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747			PENG, KUO LIANG	
			ART UNIT	PAPER NUMBER

1712

DATE MAILED: 09/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/644,976

Applicant(s)

KOZAKAI ET AL.

Examiner

Kuo-Liang Peng

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 6/16/06 Amendment.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 4-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1 and 4-8 is/are allowed.
- 6) ☒ Claim(s) 9, 11-16, 18 and 19 is/are rejected.
- 7) ☒ Claim(s) 10 and 17 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The Applicants' amendment filed on June 16, 2006 was received. Claims 1, 6 and 9-11 are amended. Claims 2-3 are deleted. Now, Claims 1 and 4-19 are pending.

2. Claim rejection(s) under double patenting rejection in the previous Office Action (Paper No. 031406) is/are removed.

3. The text of those sections of Title 35, U.S. code not included in this action can be found in prior Office Action(s).

Specification

4. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The **form and legal phraseology** often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

The word "comprising" in the first line of the abstract is improper.

Claim Rejections - 35 USC § 112

5. Claims 1, 4-8 and 18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In Claim 1 (page 3, line 3), Claim 6 (page 4, line 11) and Claim 18 (page 11, line , the phrase "alkenyl radicals in components (A) and (B)" causes confusion because components (A) and (B) do not necessarily contain alkenyl radicals. Note that, for Claims 1 and 6, the only place where components (A) and (B) contain alkenyl radicals is the component (B) which can be a silane or siloxane compound having both Si-alkoxy and Si-alkenyl *or* Si-H. (Emphasis added) As such, the alkenyl radicals are even not necessarily present in this particular component (B). For Claim 18, none of components (A) and (B) contain alkenyl radicals. Should the specific alkyl radicals, aryl radicals and **alkenyl** radicals for R¹ and R² described in the specification (page 5, 2nd paragraph) be explicitly cited in component (A) of the

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instant claims so that when component (B) does not contain alkenyl radicals, component (A) will contain alkenyl radicals?

Claim 18 recites the limitation "alkenyl radicals" in page 11, line 1. There is insufficient antecedent basis for this limitation in the claim.

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 16 and 18-19 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the use of the **specific** organosilane or organosiloxane-modified isocyanurate compounds set forth in page 9, lines 1-3, does not reasonably provide enablement for the use of **any** organosilane or organosiloxane-modified isocyanurate compounds. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with these claims.

Claim Rejections - 35 USC § 103

8. Claims 9 and 11-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aoki (US 2002/0013386) in view of Cifuentes (US 5 508 360).

Aoki in view of Cifuentes discloses a silicone adhesive as described in paragraph 5 of the prior Office action (Paper No. 042205), which renders the instant claims unpatentable because a **silane** compound containing Si-alkoxy group and Si-epoxy group is taught.

9. Claims 16 and 18-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aoki (US 2002/0013386) in view of Dalbe (WO 00/32694).

The following column and line numbers of Dalbe are based on its U.S. equivalent (US 6 777 471).

Aoki discloses a silicone adhesive as described in the prior Office actions. Aoki is silent on the use of an organosiloxane-modified isocyanurate compound set forth in the instant claims. However, Dalbe teaches the use of trimethoxysilylpropyl isocyanurate in an adhesive composition derived from a mixture comprising a hydroxyl group end-capped polyorganosiloxane, an MQ resin containing hydroxyl groups. The motivation is to enhance the adhesion of the composition to a substrate. (col. 1, line 66 to col. 5, line 6, col. 7, line 52 to col. 8,

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line 10 and Examples) In light of the benefit mentioned, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to incorporate Dalbe's trimethoxysilylpropyl isocyanurate into Akoi's adhesive. Especially, Dalbe is in the same field of that of Akoi's endeavor.

10. Claims 10 and 17 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

None of Aoki (US 2002/0013386), Clifentes (US 5 508 360), Fujita (US 2002/0086942), Ushizaka (US 5 415 912) and Dalbe, taken alone or in combination, teaches or fairly suggests the specific component (B) set forth in the instant claims.

Allowable Subject Matter

11. Claims 1 and 4-8 are allowed.

12. The following is an examiner's statement of reasons for allowance:

None of Aoki (US 2002/0013386), Clifentes (US 5 508 360), Fujita (US 2002/0086942), Ushizaka (US 5 415 912) and Dalbe, taken alone or in

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combination, teaches or fairly suggests the specific component (C) set forth in the instant claims.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kuo-Liang Peng whose telephone number is (571) 272-1091. The examiner can normally be reached on Monday-Friday from 8:30 AM to 5:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski, can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

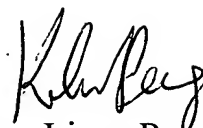
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klp

August 28, 2006

A handwritten signature in black ink, appearing to read 'Kuo-Liang Peng', written in a cursive style.

Kuo-Liang Peng
Primary Examiner
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